

No. 19833

In The

**United States Court of Appeals**  
FOR THE NINTH CIRCUIT

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RECOLD CORPORATION, a corporation and LESTER K.  
QUICK,

*Appellants,*

*vs.*

DAVID A. NURSE, d.b.a. DAVID A. NURSE COMPANY and  
HUGH ROBINSON & SONS, a corporation,

*Appellees.*

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**APPELLEES' BRIEF.**

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## APPELLEES' BRIEF.

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### JURISDICTION.

Appellants' statement of jurisdiction is not contested, by appellees, but is considered **incomplete** to satisfy the requirements of the Rules of the United States Court of Appeals for the Ninth Circuit, Rule 18(2b).

This appeal has been brought by plaintiffs from a final judgment of the United States District Court for the Southern District of California holding Quick Patent No. 2,953,906 invalid [R. 274].<sup>1</sup> The issue of infringement is not a part of this appeal.

Plaintiff, Lester K. Quick, is the patentee and legal owner of the Quick patent while plaintiff, Recold Corporation, is an exclusive licensee thereunder [Undisputed Find. of Fact. 3, R. 265].

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<sup>1</sup>The Letters Patent in suit, No. 2,953,906, will be hereinafter referred to as Quick Patent.

Plaintiff, Recold Corporation, brought this action for patent infringement against Kramer Trenton Company, a New Jersey corporation, Trenton, New Jersey, and Robert B. Holland Company, Inc. (in addition to the present defendants) alleging that the THAW refrigeration system [Ex. 9] made by Kramer Trenton Company was an infringement of the Quick patent '906. The complaint was dismissed as to Kramer Trenton and the Holland Company upon motion brought before trial [R. 35-36]. The remaining defendants, David A. Nurse, d.b.a. David A. Nurse Company (residing in Los Angeles, California) and Hugh Robinson & Sons (a California corporation, Los Angeles, California) answered the complaint denying validity and infringement and counterclaimed for a declaration of patent invalidity and non-infringement [R. 6, 154] to which plaintiff Recold replied [R. 16]. The defense of the action was assumed and controlled by Kramer Trenton Company and during trial, Lester K. Quick, owner of legal title of the patent in suit, was made a party-plaintiff together with Recold Corporation, the exclusive licensee [Undisputed Finds. of Fact 2, 4-5, R. 266].

The District Court granted a final judgment and decree holding the Quick patent, and each of the claims thereof, invalid and awarded defendants their costs [Judgment III, IV, R. 275]. The District Court's jurisdiction arose under the patent laws of the United States, Title 35, U.S.C. §281 and under the provisions of Title 28, U.S.C. §§1338(a), 1400(b) and 2201. This Court of Appeals has jurisdiction under the provisions of Title 28, U.S.C. §1291.

## STATEMENT OF THE CASE.

Plaintiffs' (appellants)<sup>2</sup> statement of the case and the subject matter is filled with misrepresentations and it does not correctly inform this Court. Instead of arguing about each misrepresentation, defendants believe this Court's time will be conserved by stating the case as it is established by the evidence which supports the Findings and Conclusions of the Trial Court.

A careful reading and consideration of plaintiffs' brief leads to the following conclusions:

1. Plaintiffs do not state what the purported invention of the Quick patent is supposed to be; their inability to define the invention confirms the Trial Court's judgment of invalidity.
2. Although certain findings are listed on page 8 of plaintiffs' brief, plaintiffs fail to conform to Rule 18 of this Court and do not specify with particularity wherein the findings are clearly in error. It appears that plaintiffs are simply dissatisfied with the conclusions reached by the Trial Court from the findings, but not with the facts found.
3. Plaintiffs attempt to create the impression that hot gas defrosting was not used before the Quick patent, whereas the evidence is to the contrary. Kramer Trenton was making and selling hot gas defrost systems at least five years before Quick and before Recold.
4. Plaintiffs fail to identify a single new or unobvious result obtained by Quick and ignore the

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<sup>2</sup>Appellants will hereinafter be referred to as plaintiffs, Recold and Quick; appellees will hereinafter be referred to as defendants.

admonition of the Supreme Court that the patent must be unobvious pursuant to the requirements of 35 U.S.C. §103.

5. Plaintiffs misrepresent the facts and evidence which compelled the Trial Court to correctly find that the Nussbaum patent 2,564,310, Kettering 1,978,463, and British patent 554,807 were not considered by the Patent Office.

6. Plaintiffs are forced to rely on sophistry and specious argument in attempting to overcome the established fact that the patented assembly was an invalid, obvious, old combination of elements.

7. The fact that the claims of the Quick patent have no basis in the disclosure or specification is carefully concealed in evasive and fallacious argument.

Defendants intend to clearly and concisely inform this Court as to the truth of the facts and controlling law which compelled the conclusion that the Quick patent in suit was invalid. References to evidence, exhibits and testimony will convincingly show that the findings are irrefutably sustained by the evidence. In addition, we are compelled to call your Honors' attention to at least some of the many misstatements, misrepresentations and instances of overreaching which have characterized plaintiffs' conduct prior to and during trial, and now before this Court.

It is believed that your Honors' consideration of this matter would be facilitated by a brief chronological statement of developments in the field of refrigeration and hot gas defrosting, so that the relationship between the prior art and the Quick patent is in proper perspective.

## CHRONOLOGY AS ESTABLISHED BY THE EVIDENCE.

- 1888 - Earliest disclosure relating to the use of hot gas in defrosting a refrigerator [Ex. 40, p. 1].
- 1926 - Marshall patent 1,594,422 [Ex. II, not cited by the Patent Office against Quick] discloses the usual **old combination** of compressor, cooling coils or condensers, evaporators or refrigeration coil, piping and a trap and a choke diaphragm in which the vapor is compelled to pass through an orifice very much smaller than the pipe 3 so that any slugs of liquid passing through will be held up and only so much allowed to pass as the compressor can take care of (Col. 1, lines 49 *et seq.*).
- 1934 - Kettering patent 1,978,463 [Ex. II, not cited by the Patent Office against Quick], described the use of a trap or accumulator identical to Quick's in a refrigeration system for use in preventing "slugging" of the compressor by liquid refrigerant due to defrosting [Finds. of Fact 10-12, R. 267-268].
- 1941 - British patent 554,807 [Ex. II, not cited by the Patent Office against Quick] shows a liquid accumulator 25 with an outlet tube 40, having orifice 42, to supply liquid refrigerant into the suction line to the compressor [Find. of Fact 13, R. 268].
- 1944 - Hot gas defrosting systems ("Thermobank") installed and sold by Kramer Trenton. Patent 2,440,146 [Exs. II, WW. 6-A, 6-B; Find. of Fact 18, R. 270].

- 1945 - "Thermobank" hot gas defrost systems in commercial use by Kramer Trenton [Ex. 6-A].
- 1946 - Article by Nussbaum "The 'Thermobank' Simplified" [Ex. 6-C].
- 1947 - Kramer Trenton's surge tanks in commercial public use [Exs. G, J, K, L and M; Find. of Fact 18, R. 270].  
Nussbaum patent 2,564,310 (filed June, 1947, not cited by the Patent Office). Figure 4 shows the same elements including a liquid accumulator 35 in the return line as 60 in Quick [Finds. of Fact 20, 21, R. 270-271].
- 1951 - Hart article, Exhibits P & Q. This described hot gas defrosting systems with liquid accumulator traps in the suction line to the compressor. [See Finds. 14, 15, 16 and 17, R. 269 and Ex. AT].
- 1952-1953 - Quick was installing "Thermobank" accumulator (made by Kramer Trenton) in hot gas defrosting systems in Oregon [Find. of Fact 7, R. 266].
- Nov. 19, 1953 - First sale of the apparatus of Quick patent in suit at Emery's IGA store, Salem, Oregon [See Pltf. Answer to Interrog. 12a, Ex. KK].  
"The Emery trap and system operated and functioned in the same manner as that of the patent in suit." [Find. of Fact 7, R. 267].
- Jan., Feb., 1954 - Quick makes several commercial installations embodying the apparatus of the patent in suit in Orr's Market at Eugene, Oregon and at McKay's Market [Answer to Interrog. 12c, Ex. KK].<sup>3</sup>

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<sup>3</sup>Admitted prior public use as an "expedient", see this Brief pp. 46 to 51.

May 9, 1955 - Quick files the application for patent in suit [Ex. C] more than one year after the installations and sales at Emery's store, Orr's Market and McKay's Market. "All of the elements of the trap are old and were well-known in the prior art before Quick made his first commercial installation in 1953 and before he filed his first application for patent." [Find. of Fact 9].

Nov. 19, 1955 - All claims of Quick application Serial 506,784, defendants' Exhibit C are rejected.

June, 1956 - Supplemental amendment filed referring to interview with the Examiner, attended by D.D. Wile, engineer for plaintiffs.

Jan., 1957 - Claims of Quick application again rejected by the Patent Office.

April, 1959 - After several rejections and amendments, Patent Office finally rejects the claims and clearly shows that all of the elements are shown in the prior art [See Ex. C, pp. 46-47].

Sept. 21, 1959 - Final rejection affirmed by Patent office.

Feb., April, 1960 - Additional final amendments to the claims (after interviews with the Examiner not attended by Mr. Wile) adding "without substantial evaporation" [Ex. C, pp. 82-93].

May, 1960 - Quick application allowed: patent in suit issued September, 1960.



Sept. 27, 1960

L. K. QUICK

REFRIGERANT FLOW CONTROL APPARATUS  
Filed May 9, 1955

2,958,814

Fig. 1

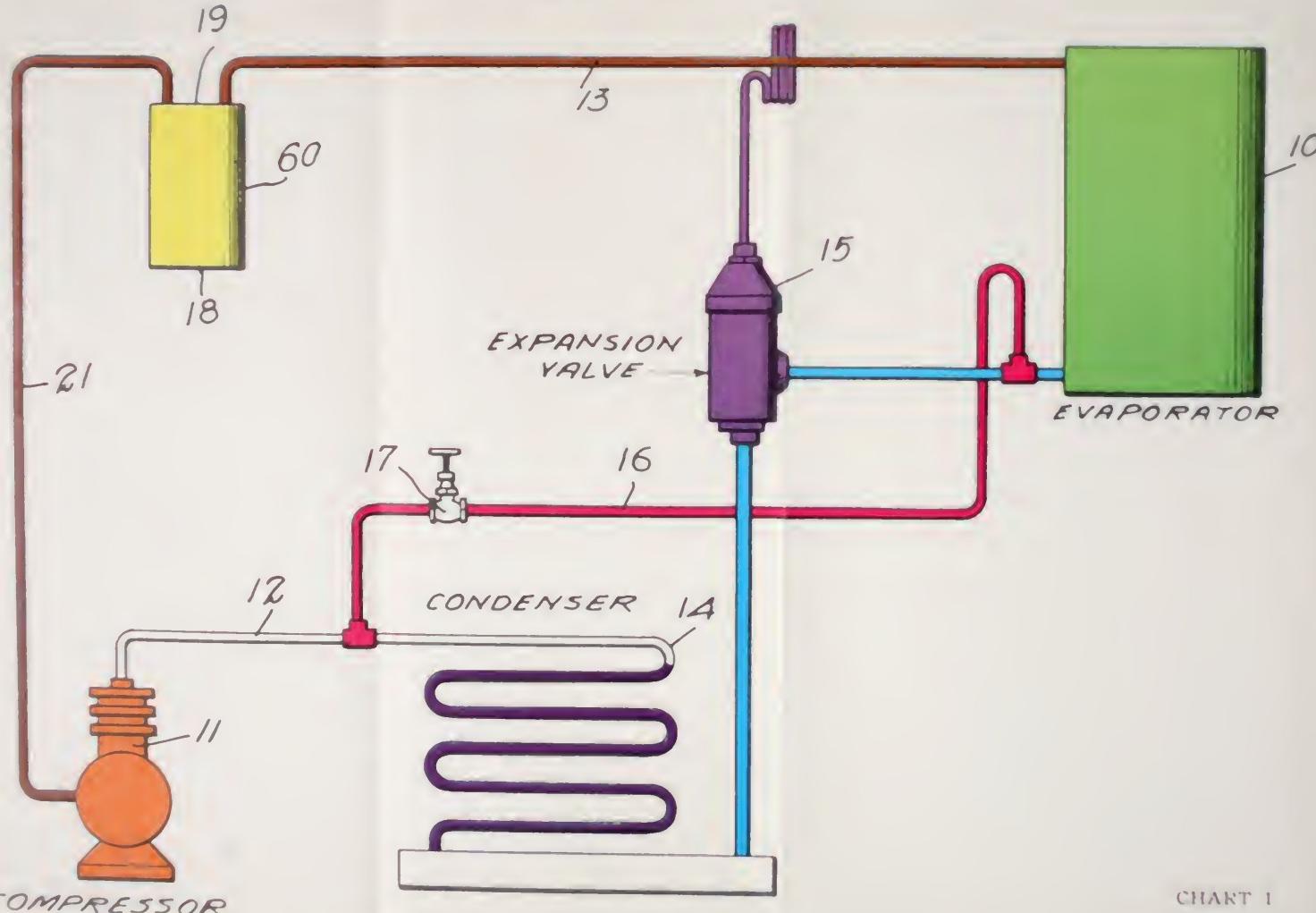


CHART 1



## THE SUBJECT MATTER.

Quick patent '906 relates to the well-known refrigeration system wherein a refrigerant gas (Freon) is compressed in a compressor, sent to a condenser to be liquefied and then passed through an expansion valve and into cooling coils of a refrigerator. When the liquid refrigerant expands into a gas, it absorbs heat (cools the refrigerator). The gas is then sent back to the compressor for re-use.

Your Honors know that the cooling coils of a refrigerator become covered with frost and the efficiency of the system is lowered. It is, therefore, desirable to periodically remove the frost. This was done long before Quick by periodically sending hot compressed gas from the compressor directly into the cooling evaporator coils of a refrigerator, thereby heating them and causing the frost to melt. Some of the gas remained in the gaseous state, but some would give up enough heat (in melting the frost) to be liquefied. The gas (and perhaps some liquid) was again returned to the compressor.

Figure 1 of the Quick patent [Exs. 1 and AP] is attached hereto as chart I with the various elements color coded for ease of presentation. The compressor 11 (orange) compresses the Freon and forces it through line 12 to the condenser 14 (violet). The cooled and liquefied gaseous refrigerant is collected in the receiver located below the condenser 14. This liquid refrigerant then passes from the receiver through liquid line (blue) to the expansion valve 15 (purple) where the pressure and temperature of the liquid refrigerant is lowered due to expansion through the valve. The expanded low

temperature refrigerant then passes into the evaporator 10 (green) within the refrigerated space to cool the refrigerator and pick up heat from the goods or products stored therein. By picking up heat, the refrigerant is converted into a gas or vapor which is then returned through suction line 13, 21 (brown) back to the compressor to be again compressed.

When it is desired to remove the frost from the refrigeration or evaporator coils, the hot gas from the compressor is sent by line 16 (red) directly into the inlet of the evaporator 10 where it gives off its heat to melt the frost covering the coils.

During the defrosting, some of the refrigerant moving from the evaporator or coils thereof toward the compressor is in gaseous form with some of it in the liquid state. In order to prevent large "slugs" of liquid from going into the compressor, Quick followed the previously recommended practice of inserting an accumulator or liquid trap 60 (yellow) in this suction line 13, 21. The trap 60 separates the gas from the liquid refrigerant, the gas passing directly into the suction line 21 while the liquid is fed slowly into the suction line at such a rate that the liquid has no perceptible effect on the compressor, or is converted into gas in the suction line if the air around the trap and suction line is warm enough.

Each and every piece of equipment and piping shown by Quick, in the same relationship, operating in the same manner for the same purposes was clearly shown in the prior art. The evidential facts which compelled the Trial Court to make its findings and hold the Quick patent invalid are discussed in detail hereinafter. However, your Honors may be interested

at this time to glance at the prior Nussbaum *et al.* patent 2,564,310 [Exs. II, AD] whose patent drawing, Figure 4, is reproduced herein as chart II. This drawing is code colored with the same colors used in the Quick drawing, chart I, and a comparison of the two charts shows the identity of the systems. It is to be noted that in chart II (Nussbaum '310) 35 represents an accumulator or liquid trap in the same position and for the same purpose as the liquid trap 60 employed by Quick.

The article by Thomas H. Hart published in "Refrigerating Engineering", February and March, 1951 [Exs. P, Q and AT] also shows a simplified diagram of the equipment on page 140 of the article, and recommends the use of an accumulator or trap in the suction line leading to the compressor in order to stop slugs of liquid (p. 247 and Chart III herein).

#### **KRAMER TRENTON HOT GAS DEFROST SYSTEMS PRECEDED QUICK.**

Testimony and exhibits relating to prior knowledge established that Kramer Trenton made and sold "Thermobank" systems with and without accumulator traps (known as surge tanks) more than five years before Quick sold and installed his Emery installation. [Undisputed Find. of Fact 18, R. 270; Exs. F, G, H, I, J, K, L, M and N; Nussbaum, Tr. 1059-1091. These surge tanks produce the same results in the same location of the system as the Quick traps and the Recold Vapots [Undisputed Find. of Fact 18, R. 270]. The "Thermobank" system is essentially a liquid trap or accumulator inserted into the refrigeration system suction line to arrest slugs of liquid which would otherwise be returned to the compressor, the liquid refrigerant trap

or accumulator being surrounded by a heat-hold jacket [Nussbaum, Tr. 889, 1051-1055, Ex. WW]. The surge tank [Exs. F and G] did not have such a heat-hold jacket. Other hot gas defrosting systems in which the accumulator or liquid trap does not have a surrounding heat jacket were also successfully employed [Hart articles, Exs. P and Q; Nussbaum, Tr. 1162].

The wide use and success of the Kramer "Thermobank" hot gas defrosting system is shown in part by the fact that the patentee Quick was installing a Kramer "Thermobank" hot gas defrosting system "on every low temperature system in every market we install" prior to 1953, including at least fifty to seventy-five and "probably more" installations [Quick, Tr. 199].

The **metering accumulator** used in the Kramer Trenton THAW system [Ex. 9] involved in this action, is a horizontal version of a **surge tank** and has the same operation, the same function and produces the same results as the surge tanks made and sold by Kramer Trenton during 1947-1955 [Find. of Fact 19, R. 270; Nussbaum, Tr. 1093, 1102-1103].

Plaintiffs erroneously represent to this Court that the water defrost system prevailed in the refrigeration industry to the time in 1954 when Recold adopted the Quick trap system of the patent in suit (App. Op. Br. pp. 2-4). Actually, the Recold water defrost method was not competitive with the Kramer Trenton "Thermobank" hot gas defrosting system and Recold was forced into adopting a hot gas defrosting system in an attempt to compete with the overwhelmingly successful and widely used "Thermobank" system [Pltf. witnesses, Jarvis, Tr. 48-50, 79-80; Wile, Tr. 417-418].

Defendants should not be deprived of employing their own inventions and developments nor from utilizing knowledge that is in the prior art. Skilled mechanics have the right to use all prior knowledge: the Quick patent cannot be sustained because its “\* \* \* effect is to subtract from former resources freely available to skilled artisans.” (*A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147.)

### THE CLAIMS OF THE QUICK PATENT ARE INVALID FOR CLAIMING AN OLD COMBINATION.

Prior art patent to Nussbaum '310 [Exs. II, AD], discloses a hot gas defrosting system having the same combination of elements in the same relationship as the elements disclosed in the Quick patent in suit. This Nussbaum patent was filed in 1947 and is owned by Kramer Trenton Company who were making and selling hot gas defrost systems long before plaintiffs Quick and Recold. This prior art patent was not cited by the Patent Office against Quick.

Figure 4 of the Nussbaum patent is reproduced herein as chart II and code colored so that your Honors can readily compare it with the drawing of Quick's patent similarly colored and shown on chart I. Note the identity of the elements and functions; during refrigeration gas compressed by the compressor (orange) flows to the condenser (violet) and receiver 5, then by line 6 (blue) to expansion valve 7 and evaporator or refrigeration coils 9 (green), and then by suction line 13 (brown) back to the compressor.

During defrosting, hot gas from the compressor is sent by by-pass line 31 (red) directly to the evaporator, and the accumulator trap 35 (yellow), in the suction

line to the compressor, holds back liquid refrigerant to prevent slugging of the compressor just as in Quick. The correctness of Findings 20 and 21 cannot be questioned. Plaintiffs admit:

"It (Nussbaum '310) does deal with a hot gas defrost operation as it indicates in the modification of Figs. 4 and 5 a bypass line 31 for bypassing hot gas from the compressor to bypass the condenser 3, receiver 5, and expansion valve 7 for the purpose of defrosting the evaporator 9. It \* \* \* shows in the suction line a container or accumulator 35 having a bottom inlet and top outlet which would thereby form a trap to hold liquid refrigerant from flowing to the compressor 1 during the defrosting operation." (Pltf. Op. Br. p. 42).

The above admission [and Finds. of Fact 20 and 21] are compelled by the uncontradicted testimony and exhibits including [Nussbaum, Tr. 1130-1132 and 1137-1146; Gabriel, Tr. 1375-1380, 1362-1369 and 1385-1386]. Plaintiffs thus admit and cannot contest the Trial Court's Findings of Fact 20 and 21, the latter stating:

"The Nussbaum patent '310 shows that the combination of elements in the system disclosed and claimed in the Quick patent in suit was old and well-known more than five years prior to Quick's use of traps and hot gas defrost systems in 1953." [Find. of Fact 21, R. 271].

The Court is thus compelled to hold the Quick patent invalid since old elements in an old combination are not patentable.

"The mere aggregation of a number of old parts or elements which, in the aggregation, perform or

produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

*Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U.S. 545 at 549.

"Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. \* \* \* Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men."

*A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147.

The above rules have been reiterated by the Supreme Court in the recent *Graham v. John Deere Company*, *Cal-Mar v. Cook Chemical* and *Colgate-Palmolive Company v. Cook Chemical* cases reported at 86 S. Ct. 686, particularly at 694.

Plaintiffs concede that the prior Nussbaum '310 provides a trap or liquid accumulator 35 in the suction line for the same purpose and function as the Quick accumulator trap 60, *i.e.*, to hold or trap liquid refrigerant and prevent it from flowing as a "slug" to the compressor during the defrosting operation. The functions of the Quick accumulator trap and the Nussbaum accumulator trap are identical; these traps are for the

same purpose in the same combination of old refrigeration equipment elements [Gabriel, Tr. 1374-1377, 1390, 1399-1404; Nussbaum, Tr. 1126-1138, 1141, 1181, 1185 and 1224; Find. of Fact 20]. No new, unobvious or surprising result is obtained by Quick from this old combination.

Plaintiffs only criticism of the Nussbaum prior patent '310 [Ex. AD] is that Nussbaum's trap 35 is not of the same construction or form as the Quick trap 60 (Pltf. Op. Br. pp. 42-44). The function or purpose is admittedly the same for both traps; both trap slugs of liquid to prevent "slugging" of the compressor during defrosting. Trap 35 of Fig. 4 of Nussbaum is only exemplary, since Nussbaum specifically states that "\* \* \* various changes may be resorted to in the form, construction and arrangement of the several parts \* \* \*" (Col. 9, lines 44-46).

A change in form or construction of a trap or accumulator is not patentable invention. Substitution of one form of trap for another form which does substantially the same thing for the same purpose in the same environment of old elements is not invention. The obviousness of such changes or substitutions was established by uncontradicted testimony of Nussbaum and Gabriel, and was obvious to the Trial Court [Find. of Fact 20; Exs. AD, II; Nussbaum, Tr. 1137-1146; Exs. AM, AN, AT; Tr. 1186-1194, Exs. AI and AS; Gabriel, Tr. 1362-1369, 1385-1386; Exs. AF, AG, AI, AJ, AK and AL]. Such substitutions and changes in form are unpatentable changes in degree, as stated by this Court:

"\* \* \*. the advance is one in degree rather than in kind. And that plainly is not enough to constitute a patentable advance. For *Lincoln Engineering Co.*

v. Stewart Warner Corp., 303 U.S. 545, 549-550 (1938) teaches us that ‘. . . the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.’ Since the advance claimed here concededly performs no different function, but merely improves on the pre-existing Lathrop patent, its status providing patent protection must be stripped away.”

*The Troy Co. v. Products Research Company.*  
9th Cir., 1964, 339 F. 2d 364.

In the light of Nussbaum, any man skilled in the refrigeration art, or even a refrigeration mechanic, can make a trap or accumulator or substitute an older trap for the one described by Nussbaum without exercising invention. He could, for example, use the trap described by Kettering for use in a refrigeration system in expired patent 1,978,463 [Ex. II] since its applicability is immediately apparent. The Kettering trap of Fig. 1 [Ex. AE] is identical to the trap 35 illustrated in Nussbaum '310. The Kettering Figs. 1 and 2 traps are obvious equivalents. In the Kettering trap:

“\* \* \* this liquid refrigerant is delayed in the trap 15 and is fed slowly and at such a rate that the liquid has no perceptible effect on the compressor.” [Ex. II, p. 1, lines 92-96].

This Kettering patent (not cited by the Patent Office against Quick) is discussed in detail hereafter.

If plaintiffs contend that Quick purportedly invented an improved trap construction, the Quick patent is invalid because it attempts to cover the old combination of old parts and pieces of equipment and their old operations as well as the trap and thereby violates the rule of *Lincoln Engineering v. Stewart Warner Corp., supra.*

If plaintiffs contend that their purported invention lies in “feeding the liquid back into the gaseous refrigerant at a controlled rate” so as to prevent “slug-ging”, then the Quick patent is invalid since that group of words or description is not a statement of a mechanical construction, but only a restatement of the function or operation of the old Kettering trap which is in the public domain and cannot be patented again, either alone or in combination with other old elements.

“\* \* \* Patentees are not entitled to a monopoly for the judicious use of materials the use of which would produce the result to be expected from such selection. Recognition is not invention. *Continental Fibre Company v. Formica Insulation Company*, 287 F. 455; *Vitamin Technologists, Inc., a Corporation v. Wisconsin Alumni Research Foundation*, 9 Cir., 136 F. (2d) 318; *Aero Neck-Band & Collar Company v. Beaver Mfg. Co.*, 97 F. (2d) 363, 365.”

*Kalich v. Paterson Pacific Parchment Co.*, 137 F. 2d 649 (C. A. 9).

The facts and the law sustain the Trial Court's findings and Judgment of invalidity.

## THE TRAP OF THE KETTERING PATENT IS IDENTICAL IN FUNCTION AND OP- ERATION TO QUICK'S TRAP.

Plaintiffs' representation is false and contrary to the facts and evidence when they state that Quick was the first to devise a method which did not completely re-evaporate liquid refrigerant before it was returned to the compressor (Pltf. Op. Br. p. 6).

The claims of the Quick patent call for return of the refrigerant "without substantial evaporation" (see Col. 4, line 4; Col. 5, line 14; Col. 6, line 9 and lines 28-29).

In the specification of the Quick patent, it is stated that most of the refrigerant will be re-evaporated and returned to the compressor in gaseous form (Col. 4, lines 2-4). Quick also states that:

"\* \* \* any portion not evaporated, along with any oil, is in such small amounts as to have no tendency whatsoever to damage the compressor." (Col. 3, lines 45-48).

We must remember that liquid refrigerant always includes some liquid oil originating at the compressor by leakage past the pistons, and this oil is returned to the compressor.

From the Quick patent specification it appears that it does not make much difference whether all or a part of the liquid refrigerant is evaporated before it reaches the compressor as long as large slugs are not returned.

How does this differ from the prior art? There is no difference.

The Hart article, Exhibits P and Q, published early in 1951 discusses hot gas defrosting and recognizes that the return of slugs of refrigerant to the compressor would result in noisy operation, particularly when high speed compressors are used. So Hart states

“The remedy in this case is an accumulator in the suction line arranged to stop the slugs of liquid, allow them to re-evaporate, and at the same time provide for the return of oil to the compressor.” [Ex. Q, p. 247].

That is exactly what Quick did. He simply followed the recommendations of the prior art. And a satisfactory accumulator trap is clearly shown in the expired Kettering patent.

Kettering describes a trap in the suction line to a compressor of a refrigeration system. He recognized that when a large quantity of liquid refrigerant entered a compressor, it would operate noisily and could even be damaged. Therefore this Kettering patent states

“It is among the objects of this invention to provide means for preventing or delaying this flow of liquid refrigerant into the compressor while permitting a substantially uninterrupted flow of gaseous refrigerant to the compressor.” (p. 1, lines 11-16).

The Kettering trap [Ex. II, Fig. 2] was cylindrical, tubular, vertical and resembled the Quick trap. Here is his description of the essential elements of the trap and its operation in preventing slugging:

“However, according to my invention, this liquid refrigerant is delayed in the trap 15 and is fed very slowly and at such a rate that the liquid has

no perceptible effect on the compressor." (p. 1, lines 92-96).

"It is provided with a substantially unrestricted gaseous refrigerant passage or intake 36 and with a **restricted liquid refrigerant drain** 37 below the gaseous refrigerant intake 36." (p. 1, lines 102-106).

"A slight amount of liquid refrigerant is allowed to pass through the drain 37 and is picked up by the gaseous refrigerant and **is carried to the compressor** 10." (p. 1, lines 115-118).

The Kettering trap therefore provides means for accomplishing every function of the Quick patent. It is located in the same suction line leading to a compressor; it stops slugs, it permits gaseous refrigerant to pass through quickly and directly, and it feeds or meters the liquid slowly. The slight amount of liquid refrigerant allowed to pass is "picked up" by the gaseous refrigerant. Kettering mentions the fact that the size of the drain is such that the amount of liquid refrigerant passing through the pipe is insufficient to harm the compressor.

Here is a complete teaching that answers all of the requirements of the accumulator traps referred to by the Hart article. Although the anticipatory effect of Hart, the Nussbaum patent and Kettering should be obvious to anyone, both Nussbaum and Gabriel testified at length concerning the identity of the systems with the system disclosed by Quick and the identity of the operations and functions performed by these prior art publications and patents. See for example, Nussbaum's testimony Tr. 1179-1199 and 1229-1230 and Gabriel's testimony Tr. 1383-1390 and 1398-1400 and 1404. The Kettering

trap is of substantially the same construction as the trap used by Quick in the Emery 1953 installation and operates in the same manner to produce the same result as the trap or accumulator of the Quick patent in suit [Find. of Fact 12, R. 268].

The Trial Court's Findings of Fact 10, 11, 12, 14, 20, 23, 24 and 26 were inescapable in view of the evidence.

#### IT WAS OBVIOUS TO QUICK TO UTILIZE PRIOR KNOWLEDGE.

Quick had been installing refrigeration equipment as a partner in Quick & Olsen of Salem, Oregon for about six years [Tr. 197, 198] and had made many installations of the Kramer Trenton hot gas defrosting system by 1953; "I would say 50 to 75 at least, probably more" [Tr. 199]. He was therefore familiar with hot gas defrosting and the surge tanks and accumulator traps used by Kramer Trenton.

In the fall of 1953, he sold and installed a standard Larkin system [Ex. Y] at Emery's IGA store in Salem, Oregon [Tr. 200]. The standard original equipment so installed was the same old combination;

"Q. So as original equipment—let's try to get this clear now—you had the compressor, receiver, condenser, the evaporator, and you had a hot gas defrost line running from the compressor to the evaporator; is that right?"

"A. That is correct" [Tr. 249].

After the system was installed and started operation, Quick observed that the compressor was vibrating, so

he quickly built and within five days installed a trap in the suction line.

“\* \* \* As I remember I just took a large piece of pipe which probably was three inches in diameter or four inches in diameter and maybe six or eight inches long, put two caps on it, put a pipe into the top that extended just barely into the top, put a pipe in the bottom that extended almost to the top, and drilled a small hole in the side of the bottom pipe so that no accumulation of oil would occur in this accumulator.

“Q. What operation was performed by that accumulator?

“A. It separated out the liquid that was coming back from the coil being defrosted, and allowed it to slowly re-enter the suction line through the hole that I had drilled in the outlet pipe and thereby returning it slowly to the system, and corrected the problem so that I had no more problem with the compressor.” [Tr. 202].

Quick apparently did not want to spend money for a “Thermobank” so he built his own trap and was proud that:

“A. I sold a working system.

“Q. Did you charge them anything extra for the trap? A. No.

Q. In your mind, was the trap part of the original purchase price? A. No. It was something extra that I gave them over and above what I had bargained to give them. And I could have left the system working and it probably would have held together, but it wouldn't have been right and I knew it wouldn't be right.” [Tr. 252-253].

Quick is to be commended for his desire to sell a good job, which was "working fine" two or three years later [Tr. 268] but plaintiff Recold is not to be permitted to attempt to monopolize (under the guise of a patent) the mechanical skill of a refrigeration mechanic who simply used what was clearly taught by the prior art. Please note that Quick did not have to do any experimentation; as soon as he saw the compressor vibrating, he knew that he needed a trap in the suction line so as to feed this liquid "slowly and at such a rate that the liquid has no perceptible effect on the compressor" (as stated in the expired Kettering patent) or place the trap and suction line in proximity to sufficient warm air so that the slugs of liquid would vaporize before they reached the compressor. These alternatives were clearly taught by the prior art and in the "Thermobank" system which had been in use for many years.

But the exercise of judgment, a change in form without a change in substance, a change in degree or size,

"\* \* \* if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." is not patentable (35 U.S.C. §103).

It is only normal to make minor structural changes in size of a device in order to make it conform to the size of the compressor and coils being used in the system; variations in form, minor changes in degree are not inventive whether they are applied to a device described in the patent in suit or to a prior art device.

The circumstances of this initial commercial installation clearly show the obviousness of the subject matter of the Quick patent.

It is to be remembered that there is no difference between the trap sold and installed by Quick in 1953 and the devices being manufactured and sold by plaintiff Recold under the Quick patent.

“Q. Well, there wasn’t any difference between the trap that you installed in 1953 and ’54 and this vapot in the vapomatic that Recold is installing is there? A. Nothing other than incidental structural shape changes, etc.” [Quick, Tr. p. 299].

The present case is a glaring example of an instance where a large corporation (plaintiff Recold), peddling a water defrost system which is losing ground to a hot defrost system sold by another (Kramer Trenton), makes an agreement with a mechanic (Quick), hires shrewd lawyers to obtain a patent from a Patent Office that does not cite pertinent art, and then attempts to enforce an invalid patent upon the public and to eliminate a competitor. Public policy requires that under such circumstances, and in accordance with the statutory requirements governing patentability, the Courts hold the patent invalid.

“There is evidence that some patent owners assert their patents not to vindicate their rights, but to harass competitors by burdensome patent infringement litigation or by the threat of such litigation. Courts and critics of the patent system have perceived this abuse. It is recognized that in many instances patents serve not to reward an inventor or his assignee for a single contribution to technology, but as an instrument of unfair competition.”

Ladd, *The University of Chicago Law Review*,  
Spring, 1959, Vol. 26, No. 3, pp. 353-354.

## INVALIDITY AS A MATTER OF LAW IS COMPELLED BY IRREFUTABLE FIND- INGS OF FACT.

After thirteen days of trial, plaintiffs were compelled to admit that a refrigeration system including a compressor, a condenser, an evaporator or refrigerating coil, a return line to the compressor and a separate line for sending hot compressed gas from the compressor to the evaporator or refrigeration coil for defrosting, were old, well-known, and well-described in the literature and often used in refrigeration systems. Even Quick, a refrigeration mechanic working in the small town of Eugene, Oregon, "had prior experience in installing commercial hot gas defrost systems" employing all these elements [Find. of Fact 7; Quick, Tr. 199]. The use of "hot gas" from the compressor to defrost the evaporator or refrigeration coil was well-known, even to Quick.

It was also known that a compressor should not have large slugs of liquid fed into it, although it could handle small quantities of liquid.

Quick, as a handy refrigeration mechanic, **thought he made a new trap** or accumulator which prevented large slugs of liquid to pass into the compressor. [Please note that the first abandoned Quick patent application was entitled "Accumulator Trap for Refrigerating Systems"; Plaintiffs' Exhibit 2]. It is significant to note that Quick did not claim to have invented a hot gas defrost system.

What Quick did not know, but which was clearly proven during trial, is that it was well-known that a trap or accumulator would restrain large slugs of liquid

and when this was done, the compressor operated very easily.

“However, according to my invention, this liquid refrigerant is delayed in the trap 15 and is fed slowly and at such a rate that the liquid has no perceptible effect on the compressor.” [Ex. II, expired Kettering patent 1,978,463 of 1934, p. 1, lines 92-96].

Therefore, the Trial Court correctly found:

“9. All of the elements of the Quick trap are old and were well-known in the prior art before Quick made his first commercial installation in 1953 and before he filed his first application for patent. The prior art taught it was old to have means, such as a trap, in the suction line to separate liquid and gaseous refrigerant and have the liquid refrigerant metered back into the suction line in restricted and small amounts so as not to cause damage to the compressor.” [Also see Finds. 10 and 11].

Workers in the art knew that you could (1) evaporate all liquid refrigerant before you sent it back to the compressor, or, (2) put in a trap to hold back or delay the flow of liquid and feed it in “\* \* \* slowly and at such a rate that it has no perceptible effect on the compressor.”

The Quick patent does not contribute an iota of information over and above what was already known. The Quick patent was issued by inadvertence because:

“The Patent Office did not consider this Kettering patent during the prosecution of the patent in suit.” [Find. of Fact 12].

Perhaps Quick, a refrigeration mechanic working in a small town, did not know of the Kettering Patent and had not read the various publications and patents introduced in evidence during trial, but the fact remains that this prior knowledge was available to those skilled in the art.

“It is also irrelevant that no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search \* \* \* a prudent and nowadays common preliminary to well-organized research.”

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, .... S.Ct. 684, 703 (1966).

Therefore, there was no actual invention made by Quick. However, he had an enterprising patent attorney and obtained a patent through the use of ambiguous, indefinite language, sophistry, and circumlocution. The application filed on behalf of Quick in May, 1955, which became the patent in suit, is a weasel-worded masterpiece of contradictions. For example, in Col. 4, of the patent, in lines 2-6, the patent states that the liquid refrigerant is to be “\* \* \* re-evaporated and returned to the compressor in gaseous form”.

But in lines 47 to 51 of the same column of the patent, the above statement is contradicted and now states that the liquid is returned “without substantial re-evaporation” for re-compressing “said stream of gas and liquid” in the compressor.

Attention is called to these contradictions since they exemplify the over-reaching and sharp tactics employed by plaintiffs in deliberately clouding the issues.

Fortunately, the Trial Court was not misled by semantics. There is no patentable difference between the undefined “pre-determined rate” of return of gaseous and liquid refrigerant (as stated in the Quick patent) and what Kettering described in his expired patent as the return of the refrigerant “slowly and at such a rate that it has no perceptible effect on the compressor”. The Trial Court correctly found:

“12. The Kettering trap disclosed in patent No. 1,978,463 is of substantially the same construction as the trap used by Quick in the Emery 1953 installation and operates in the same manner to produce the same result as the trap or accumulator of the Quick patent in suit No. 2,953,906.”

Because of the conflict and contradiction between the statements in the claims and the statements in the specification of the Quick patent, the claims must be held invalid since they do not respond to the requirement of 35 U.S.C. §112, which, for the purpose of protecting the public and letting them know what has been patented, required a clear, definite statement of the purported invention in the claims.

Certainly the claims of the Quick patent are invalid since they do not contribute a single iota of new, inventive, non-obvious invention. The prior art tells what to do: any skilled refrigeration mechanic can follow the instructions of the prior art. The Quick patent attempts to re-patent and monopolize that which is in the public domain. The Quick patent was correctly held invalid.

## PLAINTIFFS CONSISTENTLY MISREPRESENTED THE TEACHINGS OF THE PRIOR ART.

The Quick patent in suit was obtained through misrepresentations of the prior art to the Patent Office. The file history, Exhibit C, which includes affidavits by Mr. Wile, establishes that certain prior art references showing liquid refrigerant accumulators were misrepresented to the Patent Office as supposedly showing oil separators [Find. of Fact 27, R. 272]. Such misrepresentations were admitted by Mr. Wile at the time of trial [Find. of Fact 27, R. 272].

The District Court also found that the file history of the patent in suit and the unrefuted testimony of Mr. Gabriel conclusively established that the Hart article was misrepresented to the Patent Office. The plaintiffs there asserted that the Hart system required a heat exchanger to "re-evaporate" slugs of liquid refrigerant during the defrosting operation [Undisputed Find. of Fact 17, R. 269; Gabriel, Tr. 1437-1441]. When Hart referred to the use of a heat exchanger in the accumulator, he specifically stated it should be used "during the refrigeration cycle, but not during defrosting" [Undisputed Find. of Fact 17, R. 269; Gabriel, Tr. 1440; Ex. Q, p. 248]. The Hart heat exchanger 13, not used during defrosting, is shown in Exhibit AT included herein as Chart III. Plaintiffs' commercial Vapot system advertised and sold by plaintiffs under the Quick patent employs the same structure as taught by Hart including such heat exchanger [Undisputed Find. of Fact 17, R. 269; Nussbaum, Tr. 1130].

The importance and anticipatory effect of the Hart article is emphasized not only by plaintiffs' misrepresentation before the Patent Office [Find. of Fact 17] but by their further misrepresentation to this Court that:

“. . . Hart teaches in Exh. Q that no trap should be used in the suction line as such use would be likely to produce a slug which would have to be evaporated. . . .” (App. Op. Br. p. 65, also pp. 42 and 57).

On the first page of Exhibit Q, Mr. Hart refers to a simple hot gas defrosting system wherein no liquid accumulator is provided in the suction line during the passage of hot gas through the evaporator to defrost it. In such a system, Hart teaches that the suction line “within the refrigerated space” should not be trapped since this might cause the collection of slugs of liquid refrigerant which would then be passed toward the compressor unless re-evaporated prior thereto. The use of the word “trap” here refers to unintentional trapping of liquid refrigerant in bends or low portions of the suction line which might otherwise occur in the design of the suction line within the refrigerated space. He was not referring to an “accumulator”.

Immediately following the suggestions of page 1, Hart specifies that while the slow speed and wide cylinder head clearance of conventional open-type compressors allows the passage of minute droplets of liquid refrigerant *through the compressor*, the newer high speed sealed or semi-sealed compressors have much closer tolerance and cannot handle such liquid droplets. He then states:

“The remedy in this case is an accumulator in the suction line arranged to stop the slugs of liquid, allow them to re-evaporate, and at the same time provide for the return of oil to the compressor.” [Hart, Ex. Q, p. 247].

THE QUICK SYSTEM AND ACCUMULATOR  
ARE FULLY ANTICIPATED BY THE 1951  
HART PUBLICATION.

The refrigeration system, means for hot gas defrosting and liquid accumulator, for preventing liquid slugging of the compressor, disclosed in the Quick patent (Chart I) are completely found in the disclosure of the Hart article [Exs. P & Q] published in 1951. During the trial, defendants' expert, Mr. Nussbaum, drew Exhibit AT which the District Court found correctly exemplifies the hot gas defrosting system including an accumulator as described by Hart [Find. of Fact 15, R. 269; Nussbaum, Tr. 1114-1119]. The system described by Hart, as exemplified by Exhibit AT, fully meets and anticipates the system as disclosed in the Quick patent in suit as to operation, function and result [Finds. of Fact 16 and 23, R. 269; Nussbaum, Tr. 1119-1122, 1126-1128].

Exhibit AT is included herein as Chart III, color coded for comparison with the system of Fig. 1 of the Quick patent (Chart I). Exhibit AT was drawn by Mr. Nussbaum by copying Fig. 3 on page 140 of Exhibit P with the addition of the combination heat exchanger and accumulator described by Hart on page 248 [Nussbaum, Tr. 1116-1118]. As seen in Chart III, the Hart system includes a compressor (orange), condensor (purple), receiver, liquid line (blue), expansion valve (purple), evaporator (green), suction line (brown) going back to the compressor and hot gas by-pass line (red) all taken from Fig. 3 on page 140 of Exhibit P [Nussbaum, Tr. 1116-1117]. A liquid accumulator 10 (yellow) having an inlet 11 and an outlet 12 is shown with a portion of the liquid line coiled up inside

the trap to provide a heat exchanger 13 within the trap which functions only during the refrigeration cycle [Nussbaum, Tr. 1117-1119, 1129].

The heat exchanger 13 of Exhibit AT and the Hart articles operates during the refrigeration cycle and helps to cool the liquid refrigerant passing from the receiver to the evaporator before it enters the expansion valve during normal refrigeration cycles [Nussbaum, Tr. 1129]. It is this heat exchanger element, inactive during defrosting, which the plaintiffs misrepresented before the Patent Office as serving to "re-evaporate" slugs of liquid refrigerant during the defrosting operation [Undisputed Find. of Fact 17, R. 269]. Plaintiffs now attempt to mislead this Court into believing that the accumulator [properly shown in Ex. AT] was the then well-known "Thermobank" system of Exhibits 6A and 6C (App. Op. Br. p. 22) which it is not.

During a defrosting operation, liquid and vapor or gaseous refrigerant separate in the accumulator 10 with the vapor or gas rising to the top of the tank and leaving through outlet line 12. The oil hole in the vertical tube 12 permits small restricted or metered amounts of liquid refrigerant and oil to pass into the outlet line 12 to the compressor. Under varying conditions, the liquid refrigerant may be re-evaporated in the suction line between the accumulator and compressor or it may reach and enter the compressor [Nussbaum, Tr. 1121-1122].

The District Court correctly found that the trap and hot gas defrosting system described by Hart and as exemplified in Exhibit AT fully meet the trap and system as disclosed in the Quick patent in suit as to operation, function and result [Find. of Fact 16, R. 269].

The Hart 1951 disclosure anticipates and precludes the novelty of the Quick patent [Finds. of Fact, 14-17, 24 and 26, Conclusions of Law 4 and 5, R. 269-273].

Appellants do not point out specifically wherein the District Court's Findings of Fact 14 through 16 are in error, but rather attempt to misrepresent the teachings of the Hart articles as suggesting that no trap should be used or that *if* a trap is used, it is intended to completely re-evaporate the liquid refrigerant "before it could be returned **to the compressor**" (App. Op. Br. p. 21). But, plaintiffs' contradict themselves in also saying that the Quick patent claims only require "without substantial re-evaporation" at the trap without reference to what may occur after the refrigerant leaves the accumulator on its way **to the compressor** (App. Op. Br. pp. 30-32).

The Trial Court's findings as to the operation of the Hart hot gas defrosting system and accumulator as exemplified by Exhibit AT are fully supported by the evidence presented through the testimony of Mr. Nussbaum at pages 1120 through 1122 of the trial transcript. The evidence before the District Court showed that Hart specifically states that there must be provision for return of oil from the accumulator into the suction line, represented by the oil hole 12 in Exhibit AT. Any such oil hole will of necessity pass restricted amounts of liquid refrigerant from the bottom of the accumulator into the suction line [Nussbaum, Tr. 1121, Also: See the identical accumulator and description thereof in the Kettering Patent, Fig. 1].

No specific means are provided at the Hart accumulator for re-evaporation of the liquid refrigerant therein [Nussbaum, Tr. 1122]. This is a requirement of the Quick claims at page 32 of Appellants' Brief. Under

favorable conditions, the heat pick-up through the wall of the accumulator may boil off the liquid refrigerant therein but under unfavorable conditions where there would be less heat pick-up through the wall of the accumulator, liquid refrigerant would enter the compressor [Nussbaum, Tr. 1121-1122], just as in the concept of the Quick system asserted in Appellants' Brief, pages 9 and 10.

Regardless of what concept is adopted by plaintiffs as to the return or non-return of liquid refrigerant to the compressor, the specific construction and functioning of the trap and hot gas defrosting system disclosed by the Hart articles, as exemplified by Exhibit AT, anticipate and fully meet the Quick patented system and trap as correctly found by the District Court. Findings of Fact 14-17, 23, 24 and 26 are supported by ample evidence and have not been shown to be clearly erroneous.

The District Court is best able to receive and weigh the value of expert testimony as to the teachings of the Hart article, Exhibits P and Q. The Appellate Court is not in a position to re-examine anew the District Court's findings as to the teachings of the Hart articles as exemplified in Exhibit AT [Find. of Fact 15 and 16] based upon the District Court's observation of the credibility of the witnesses and their testimony. The District Court has made no error. Plaintiffs should be reprimanded for their flagrant misrepresentation of the teachings and import of this Hart disclosure [Exs. P and Q] before the Patent Office and now through the fallacious arguments of counsel before this Court without regard to actual trial testimony and the interpretations made of these disclosures by persons skilled in the art.

THE ANTICIPATORY KRAMER TRENTON SURGE TANK TESTIMONY WAS CORROBORATED BY DOCUMENTARY EVIDENCE.

The Kramer Trenton Company anticipated the Quick patent by its use of the inner accumulator tank of the "Thermobank", termed a surge tank [Ex. G], beginning in 1947 to trap slugs of liquid during a hot gas defrosting cycle and hold them within the accumulator without any specific heat jacket or other means for re-evaporating the liquid refrigerant thus retained in the accumulator.

The Trial Court found that the metering accumulator used in the Kramer Trenton THAW system [Ex. 9], accused to be an infringement in this action, is in fact a horizontal version of the same identical surge tank having the same operation, function and producing the same result as the surge tanks made and sold by Kramer Trenton in 1947 and 1948 through 1955 [Find. of Fact 19, R. 270]. The District Court's findings were supported by the testimony of Mr. Nussbaum and the corroborating documentary evidence of Exhibits F through N introduced into evidence from the business files and records maintained by the Kramer Trenton Company in Trenton, New Jersey. The District Court properly found that the testimony and exhibits relating thereto established that the Kramer Trenton Company had made and sold "Thermobank" systems with or without accumulator traps known as the surge tanks more than five years prior to the time that Quick installed his first liquid trap at the Emery installation and that these surge tanks produced the same results in the same location of the refrigeration system as did

the Quick trap and the present Recold commercial devices known as Vapots [Find. of Fact 18, R. 270].

Plaintiffs attack the Kramer Trenton Company's use of the surge tanks of Findings of Fact 18 and 19 on the basis that Mr. Nussbaum's testimony was not corroborated and that Kramer Trenton Company abandoned, suppressed and concealed the surge tanks (App. Op. Br. pp. 40-41, 44-49). Significantly, no reference to any record evidence is offered by plaintiffs to support their baseless allegations.

Mr. Nussbaum's testimony on the surge tank appears in the Trial Transcript from pages 1059 through 1109. Initially Mr. Nussbaum explained how a problem of liquid overflow occurred in certain "Thermobank" installations where the "Thermobank" capacity was exceeded [Nussbaum, Tr. 1059]. He related how the concept of using liquid accumulators or traps was well-known in 1947 and to his knowledge were used on soda fountains, water coolers and domestic ice makers and were not considered an innovation [Nussbaum, Tr. 1061]. It was obvious to Nussbaum to merely use the inner tank of the "Thermobank" system (already a liquid trap) to trap whatever liquid refrigerant overflowed the "Thermobank" accumulator [Nussbaum, Tr. 1062].

Construction details of the surge tank were shown by original drawings of the Kramer Trenton Company, Exhibits F through I [Nussbaum, Tr. 1063-1077] which were used as "standard equipment" with large "Thermobank" systems [Nussbaum, Tr. 1078]. Correspondence between Mr. Nussbaum on behalf of Kramer Trenton Company and the Frigidare Sales Corporation, Acarr Supply Company and Gibson Engineering [Exs. L, M and N] indicated that surge tank drawings and specifica-

tion materials [Exs. J and K] were sent as part of the "Thermobank" systems employing the surge tanks [Nussbaum, Tr. 1084-1091].

The similarity between the defendants accused device, the THAW system of Exhibit 9, and the earlier surge tanks was shown at pages 1091 through 1109. Mr. Nussbaum's testimony was accepted by the District Court (which was best able to weigh his credibility) and was corroborated by documentary Exhibits F through N admitted into evidence. It is interesting to note that Exhibits J, K, L, M and N were all exhibits to the Nussbaum deposition [Deft. Ex. 6] in August of 1962 long prior to the trial of this action. Although plaintiffs were thus well advised as to the issues to be expected at trial, they brought forward no evidence to support their present bare allegations that Kramer Trenton Company concealed or suppressed the surge tank installations which the District Court has found were actually sold to others. Plaintiffs' cross-examination of Mr. Nussbaum [Tr. 1241, 1266-1268] in no way affected the import of his direct testimony.

The Exhibits F, G, H, and I are *original* drawings of the Kramer Trenton Company [Tr. 1063, 1072, 1075, 1074] previously maintained in the business files of the Kramer Trenton Company and were admitted into evidence without any objection being raised thereto by plaintiffs' counsel [Tr. 1082-1083].

Exhibits K and J are also *original documents* [Tr. 1087] which were admitted into evidence without objection [Tr. 1089]. Exhibit L, a carbon copy of a letter sent by Mr. Nussbaum, to Frigidare Sales Corporation in Detroit in June, 1947, was admitted to show

that the letter was sent to Frigidare with the enclosures, Exhibits K and J [Tr. 1086]. The operation of the surge tank of Exhibit J in metering liquid refrigerant at "a restricted rate through the oil return line" into the suction line is described at Transcript 1088.

Exhibit M is a carbon copy of a letter written by Mr. Nussbaum to Acarr Supply Company in October of 1947 calling the customer's attention to the special instructions of Exhibits K and J which were enclosed therein [Tr. 1089-1090]. This letter was admitted into evidence without objection [Tr. 1091]. Exhibit N is a carbon copy of a letter signed by Mr. Nussbaum and sent to Gibson Engineering in March of 1948 [Tr. 1090]. The Court properly overruled opposing counsel's objection on the ground that there was no foundation laid [Mr. Nussbaum had written the letter, Tr. 1091].

In the *Barbed Wire Patent* case, 143 U.S. 275, 284, the Supreme Court condemned the offer of proof of prior anticipations through oral testimony alone. Such is not the case here where original, dated, authenticated documents corroborating Mr. Nussbaum's testimony have been admitted into evidence without objection by plaintiffs. The District Court's Findings of Fact Nos. 18, 19, 21, 23, 24 and 26 are fully supported by clear and satisfactory evidence.

"In order to sustain this burden, appellants were not required to prove these facts beyond a reasonable doubt. It was, however, required to prove them by substantial, clear and satisfactory evidence."

*Tucker Aluminum Products, Inc. v. Grossman*,  
9th Cir., 1963, 312 F. 2d 293.

## THE DILEMMA OF WITHOUT SUBSTANTIAL EVAPORATION.

Appellants do not specify any error in the District Court's Finding of Fact 8 as to the function of the Quick trap in preventing "slugging" of the compressor. The identical function of restricting the rate of flow of liquid from an accumulator trap into the suction line to avoid "slugging" of the compressor is found in the prior art, as for example, in the Kettering Patent No. 1,978,463 [Finds. of Fact 10-12, R. 267-268]. Appellants therefore are forced to **create** a supposed patentable concept in the Quick claims not purportedly found in the prior art.

The Quick concept asserted at the beginning of Appellants' Brief is that the Quick trap not only accumulates the liquid refrigerant and meters it back into the suction line but does so:

"to permit the same to pass **through the compressor** without liability of damage to the compressor . . ." (Emphasis added). (App. Op. Br. p. 10).

The Quick concept of carrying liquid refrigerant "through the head of the compressor without damage" is presented in opposition to the supposed uniform teaching of the prior art that there must be:

"complete re-evaporation of the liquid refrigerant produced during the defrosting **before the intake of the compressor . . .**" (Emphasis added). (App. Op. Br. p. 10).

Plaintiffs uniformly assert to this Court that the only teachings of the prior art were to completely re-evaporate the liquid refrigerant **before it reaches the compressor inlet** (App. Op. Br. pp. 10-30).

The attempts of Recold to overcome the supposed skepticism of the trade to the Quick system is said to have prompted the use of demonstrators, such as Exhibit 15, to demonstrate that:

“The liquid refrigerant formed during defrosting is **not evaporated** before it is returned **to the compressor.**” (Emphasis added). (App. Op. Br. p. 26).

The Quick patent specification and claims are asserted to teach and define a system which is “independent of ‘re-evaporation’” (App. Op. Br. p. 29) and “enables the liquid refrigerant to be returned **to the compressor without ‘substantial re-evaporation’**” (Emphasis added). (App. Op. Br. p. 30).

Plaintiffs therefore have contended up to this point in their brief (p. 29) that the Quick concept is to return liquid refrigerant “through the head of the compressor without damage” while the prior art, to the contrary, teaches total re-evaporation of the liquid refrigerant before it reaches the compressor. Clearly, liquid refrigerant must be returned **to the compressor without “substantial re-evaporation”** in a hot gas defrosting operation to come within the Quick system concept and to avoid the prior art.

However, teachings of the Quick patent specification, contrary to the **claims** and the concept asserted by plaintiffs before this Court, is to re-evaporate the liquid refrigerant “for the most part” before it reaches the compressor [Quick Patent Ex. 1, Col. 3, lines 44-48 and Col. 4, lines 2-6.]

The patentee admitted this was true as to his installations:

“Q. Would you say that the liquid in these prior installations, in Emery, Orr’s and McKay jobs

would have substantially re-evaporated when the refrigerant was being returned to the compressor?

A. I would say so.

Q. Would your system have operated satisfactorily when you installed the trap if the refrigerant was without substantial re-evaporation? A. It would not have." [Quick, Tr. 337].

The claims of the patent in suit, however, require the return of liquid refrigerant **to the compressor without substantial re-evaporation**. They are invalid for being ambiguous because of this controversy between the patent claims and the specification and the Quick installations [Find. of Fact 25, R. 271-272; Gabriel, Tr. 1451-1461.]

Plaintiffs ignore their earlier expressed Quick "concept" and argue that the requirement of "without substantial re-evaporation" in the claims only refers to what must occur **in the accumulator trap** (App. Op. Br. pp. 31-32). They are thus in the dilemma of having stated that the Quick concept is to return liquid refrigerant **to the compressor** (to avoid the supposed prior art teachings of total re-evaporation **prior to the compressor**), but because of the patent specification are forced to **misinterpret** the patent claims as requiring "without substantial re-evaporation" only **at** the accumulator trap and not prior to the compressor.

Plaintiffs attempt to reshape the prior art teachings at page 60 as teaching complete re-evaporation **in the accumulator trap** of liquid refrigerant before it is admitted to the suction line (to conform to their claim misinterpretation), whereas they have previously attempted to distinguish the prior art only as teaching re-evaporation of liquid refrigerant **prior** to its reaching

the **compressor** (to distinguish from the supposed Quick “concept” of returning liquid refrigerant “through the head of the compressor”). This appears to be a concerted effort to confuse the Court, misrepresent the prior art and relitigate the issues of this case without regard to the Findings of Fact and Conclusions of Law entered by the District Court.

The District Court recognized that the prior art teaches the same construction, function and mode of operation for accumulators and hot gas defrosting systems as that disclosed in the Quick patent. Quick is anticipated by the prior art and no theory of claim interpretation created by counsel can avoid the legal effect thereof of invalidating the Quick patent. Whether the Quick system operates without substantial re-evaporation of the liquid refrigerant in the accumulator trap, in the suction line prior to the inlet to the compressor or in the compressor, the same construction, arrangement and function of the individually old elements are found in the prior art and the patent is invalid.

#### **The NUSSBAUM '310 AND KETTERING PATENTS WERE NOT BEFORE THE PATENT OFFICE.**

Neither of the Nussbaum '310 nor Kettering patents [Ex. II] are references cited by the Patent Office [Ex. 1]. Neither are mentioned anywhere in the file history [Ex. C]. The District Court correctly found that the Patent Office had not considered the Kettering and Nussbaum '310 patents during prosecution of the patent in suit [Finds. of Fact 12 and 20, R. 268, 270].

Plaintiffs' only basis for arguing to the contrary is the reference to several patents “and others” at page

61 of the patent file history in an affidavit of Mr. Wile filed in 1959 [Ex. C]. During the trial, plaintiffs attempted to include all of defendants' prior art references within the "and others" [Wile, Tr. 825, *et seq.*]. Defendants' objection to the presentation of a supposed "list of such patents" was sustained by the District Court on the ground that the subject matter was outside the area of cross-examination on which plaintiffs could proceed on redirect [Tr. 27 and 30]. However, the District Court allowed plaintiffs' counsel to reopen on that issue [Tr. 832]. Counsel then stipulated that plaintiffs could read in their list of "and others" for the specific and sole purpose of alleging that the references showed "oil traps in the suction line" [Tr. 834-836].

The District Court did not exclude any of plaintiffs' evidence and did not refuse to consider it. On the contrary, the District Court did consider it, the evidence was presented, but the District Court concluded that it was **insufficient** to show that the Patent Office **had considered** these references, the Court stating on the hearing with respect to the settling of Findings of Fact:

"THE COURT: As I recall, there was nothing in the record that showed that the Kettering patent had been brought to the attention of the Patent Office.

"MR. POMS: That is right.

"THE COURT: Mr. Wile did say that they had been in some manner, and I remember at the time that I did not feel that his statement was such as would be the proper basis for a finding that they had.

\* \* \*

"THE COURT: . . . but his testimony was not firm and sure that this was done." [Tr. proceedings of August 10, 1964, pp. 28-29].

Plaintiffs also failed to place Mr. Wile in the Patent Office at an interview in 1959 to discuss the "and others" as asserted in Plaintiffs' Brief at page 34. At the trial, Mr. Wile asserted that he had been to **only one** Patent Office interview which he recalled vividly because it was his first appearance before the Examiner [Wile, Tr. 426-427]. The photos of Exhibit 14 were supposedly shown to the Examiner at this interview [Wile, Tr. 470-472]. On cross-examination, it was conclusively demonstrated that the one interview Mr. Wile attended [Tr. 486-488] occurred earlier in 1956 [Tr. 490-498]. As is the custom, the Wile 1956 Patent Office interview is noted in the file history [Ex. C, p. 26]. The photographs of Exhibit 14 referred to were also listed in the 1956 supplemental amendment [Ex. C, pp. 28-30]. No mention is made anywhere else in the file history of any other interview at which Mr. Wile was present.

It is significant that plaintiffs do not advise this Court as to a date or record evidence for the "interview" they refer to at page 34 of their Brief. Defendants showed that the only evidence of any interview at which Mr. Wile was present occurred in 1956. The Exhibit G, page 61, portion of Mr. Wile's affidavit in which he referred to the "and others" **occurred in 1959**. Further, the "and others" referred to at page 61 of Exhibit C are supposedly referred to as showing "oil separators". The District Court correctly found that plaintiffs were misrepresenting the prior art to the Patent Office at this particular point [Find. of Fact 27].

The prior art patents did not show "oil separators" in the suction line but in fact showed liquid accumulators for the purpose of trapping slugs of liquid refrigerant and returning them, together with any oil inadvertently trapped, into the suction line at a restricted, metered rate. Plaintiffs' actions before the Patent Office, before the District Court, and now before this Court of Appeals are consistent in misrepresenting the facts.

### THE QUICK PATENT IS ALSO INVALID BECAUSE OF QUICK'S PRIOR PUBLIC USE AND SALE.

The sales and public uses of Quick's accumulator traps in Oregon more than one year prior to the filing date of the application for the patent in suit [May 9, 1955, Ex. C] invalidate the patent as a matter of law (35 U.S.C. sec. 102(b)). The claims of the Quick patent in suit are not entitled to a filing date earlier than May 9, 1955, although prior applications had been filed [Exs. 2 and 3].

Plaintiffs may not rely upon the December 4, 1953 Quick application entitled "ACCUMULATOR TRAP FOR REFRIGERATION SYSTEMS" [Ex. 2] because there is no reference to this application in the patent in suit (*Hovlid v. Asari*, 305 F. 2d 747, 9th Cir. 1962).

The second Quick application, filed June 15, 1954. [Ex. 3] does not disclose a hot gas defrosting system and therefore is not a prior disclosure supporting the claims of the patent in suit:

"A filing date, to be effective, must be that of an application which supports the claims. Appellants' earlier applications fail them in this respect."

*Ruscetta & Jenny*, 255 F. 2d 687 (C.C.P.A. 1958).

The patent in suit issued from an application [Ex. C] admittedly adding new matter over the disclosure of the former application [Ex. 3], it being termed a “continuation-in-part” thereof.

“A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in the said earlier case. (In re Klein, 1930, C.D. 2; 393 O.G. 519)”

*Manual of Patent Examining Procedures*, 3rd Ed., Section 201.08

The 1954 Quick application [Ex. 3] failed to show and/or describe a means for defrosting the evaporator, the patentee attempting to claim a liquid accumulator in a conventional refrigeration system. When the patentee attempted to introduce claims into the 1954 application including reference to hot gas defrosting, the Examiner rejected them as including “new matter”.

“Claims 9 and 10, which were added by recent amendment, are rejected on the ground of new matter. These claims mention the ‘delivery of hot refrigerant’ and ‘means whereby the refrigerant—is delivered to the evaporator—will defrost the evaporator’, which statements do not fall within the confines of the original disclosure.” [Ex. 3, p. 32].

The patentee’s counsel apparently expected this new matter rejection in the Exhibit 3 application because the application of Exhibit C (which issued as the patent in suit) was filed concurrently therewith. The 1955 application included as claims 1 and 2 the prior claims 9 and 10, and added a hot gas bypass line 16 to the disclosure [Ex. C, pp. 12-16]. The patentee’s failure to

appeal the Examiner's holdings of "new matter" in the prosecution of the second application [Ex. 3] in favor of the third application [Ex. C] estops plaintiffs now, as a matter of law, from denying the addition of new matter to the patent in suit limiting its claims to the May 9, 1955 filing date.

"The appellant did not seek review of that holding (new matter) of the Examiner by petition or appeal and it accordingly became final and is not subject to review here."

*In re McIntosh*, 230 F. 2d 615, 618 (C.C.P.A. 1958) to the same effect:

*Philip A. Hunt Co. v. Mallinckrodt Chemical Works*, 177 F. 2d 583 (2nd Cir., 1949);

*Hazeltine Research, Inc. v. General Motors*, 170 F. 2d 6 (6th Cir., 1948).

In the fall of 1953 when Quick sold and installed the standard Larkin refrigeration and hot gas defrosting system at Emery's I.G.A. store in Salem, Oregon [Quick, Tr. 200], he promptly built and installed a single accumulator or trap in the suction line for that system as "an expedient" to make the system work without vibration [Quick, Tr. 203, See this Br. pp. 22-23]. In the patentee's own words, this first sale at Emery's I.G.A. store was an "**expedient**". Plaintiffs identified this Emery installation and trap as being the **first public sale** of the patented apparatus before Trial [Plaintiff's answers to defendants' interrogatories 12 and 16, Ex. KK]. Plaintiffs never withdrew, modified or denied these interrogatory answers identifying the Emery installation as the first sale of the patented apparatus. The patentee, Mr. Quick, affirmed these answers on his deposition prior to trial and during trial [Quick, Tr. 356-359].

No effort was made to hide the trap or place any limitations on the use of the successfully-operating commercial Emery system [Quick, Tr. 254-256]. The patentee never made any changes or replaced any traps and didn't go back to see the Emery installation until two or three years later, at which time it was "working fine" [Quick, Tr. 268]. As far as he knows, it is "still working fine" [Quick, Tr. 269].

Quick installed nothing but similar traps in all of his commercial installations after the Emery job [Quick, Tr. 297-300]. One such sale was made to McKay's Market on February 15, 1954 [Quick, Tr. 285-290]. As with the Emery trap, Quick never went back to look at the McKay trap, to repair it, or to replace it because it apparently worked fine:

"Q. Did you have occasion to go back and look at your trap? A. No, I did not. I haven't looked at the trap for five years, I would say.

Q. Well, after you installed the trap in February, 1954 in these meat case refrigeration systems, **it worked fine**, didn't it? A. It did.

Q. And did you ever have to make any changes in that trap? A. I did not." [Tr. 292].

"Q. Mr. Quick, did you instruct Mr. McKay not to show that particular trap that is shown on Exhibit AA? A. No. I had no reason to." [Tr. 297].

"Q. Did you ever have to go back and repair or change this trap in the meat cooler installation in McKay's Market? A. I testified last Friday that **I never repaired or changed a trap on any installation anywhere.**" [Tr. 318].

"A. All that I made worked satisfactorily." [Tr. 335].

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"A. All that I made worked satisfactorily." [Tr. 335].

During the trial, plaintiffs' counsel repeatedly referred to these early Quick sales as being only experimental sales. But merely calling a commercial, operating installation an experiment does not make it so. The only evidence presented of anything resembling an experiment by Quick was when he tried a warm water coil around a trap at the Orr's market job [Tr. 203-205], which was promptly abandoned [Tr. 273]. The early installation by Quick worked perfectly from the start without any change. It is well settled that once a defendant has shown an installation prior to the permitted statutory year, the burden of proof is transferred to the plaintiff who must convincingly establish actual experimentation:

“However, once a *prima facie* demonstration of the claimed use has been made, the inventor carries the burden of showing that the use was not of a functionally operative device, or was substantially used for experimentation or testing purposes and this must be demonstrated by **strong and convincing proof**. *National Biscuit Co. v. Crown Baking Co.*, 105 F. 2d 422 (1st Cir. 1939).” (Emphasis added).

*Atlas v. Eastern Air Lines, Incorporated*, 311 F. 2d 156 (9th Cir. 1962).

Quick never repaired, replaced or modified a trap. There was no experimentation, but rather public use under commercial service conditions.

“\* \* \* the overalls embodying the patented features were complete at least by the middle of 1947 and the boy's use in November and December was one under **service conditions** to see how well the overalls filled their function rather than experimen-

tal. (*Aerovox Corp. v. Polymet Mfg.*, 67 F.2d 860)  
\* \* \*

*Merry Hull & Co. Hi-Line Co., Inc.*, 243 F.  
Supp. 45, 54 (D.C. S.D. N.Y., 1965).

The Emery trap is of substantially the same construction and operates in the same manner to produce the same result as the trap or accumulator of the Quick patent in suit [Find. of Fact 12]. The hot gas defrosting systems installed in Emery's, and thereafter in Oregon, were commercial systems [Finds. of Fact 7 and 9] sold and in public use.

“We observe in the first place, that to constitute the public use of an invention it is not necessary that more than one of the patented articles should be publicly used. \* \* \*

“If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person.”

*Egbert v. Lippman*, 105 U.S. 333, 336 (1881),

“The ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use.”

*Electric Battery Co. v. Shimadzu*, 304 U.S. 5.  
20 (1939).

The Quick patent is invalid under the provision of 35 U.S.C. Sec. 102(b). The weight of the evidence compels such a conclusion. Any finding to the contrary would be clearly erroneous.

## THE PATENT IS INVALID BECAUSE ISSUED UPON A FALSE OATH.

Although Quick had begun installing accumulator traps on all installations after the Emery I.G.A. store job in the fall of 1953 [Quick, Tr. 297-300], he stated in the oath supporting the application filed May 9, 1955 [Ex. C] which issued as the patent in suit, that:

“I do not know and do not believe that this invention was \* \* \* in public use or on sale in the United States for more than one year prior to **this** application.” (Emphasis added). [Ex. C, p. 15].

The patentee must be conclusively presumed to know that his oath was false since he was a party to the sales in late 1953 and early 1954 more than one year prior to the filing of the application in May of 1955 which issued as the patent in suit.

“Under the decisions of this Court a person sued for infringement may challenge the validity of the patent on various grounds, including **fraudulent procurement**. E.g., Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 65 USPQ 133 (1945); Hazel-Atlas Co., v. Hartford-Empire Co., 322 U.S. 238, 61 USPQ 241 (1944); Keystone Drilling Co. v. General Excavator Co., 290 U.S. 240, 19 USPQ 228 (1933).”

*Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.*, 382 U.S. 172, 86 S. Ct. 347, 15 L. Ed. 247 (1965).

The patentee, Quick, and Recold's officers and attorney, in complete disregard of the prior commercial installations of Quick, deliberately and knowingly obtained an invalid patent and brought this suit with that knowledge. The patent in suit is not only invalid for the many

grounds relied upon by the District Court in its Findings, because of the prior public use and sale, but also because of this **fraud** upon the Patent Office in asserting the absence of prior public use or sale more than one year prior to May 9, 1955.

## CONCLUSION.

The District Court's conclusion of patent invalidity should be affirmed. Plaintiffs have failed to show that the trier of fact made any findings which are either clearly erroneous or contrary to the weight of the evidence. They have not demonstrated any erroneous application of law to the facts. Plaintiffs' arguments on appeal as to what the Findings should have been in their view are without merit.

The conclusion that the Quick patent is merely an obvious old combination of old elements is inescapable. It is no more than the result of the exercise of ordinary skill by a refrigeration mechanic who installed a simple liquid refrigerant trap as an "expedient" on a job where he was attempting to avoid the use of the prior "Thermobank" liquid accumulators he was familiar with. The trap employed by Quick is found in prior patents, such as the Kettering, British, and other prior art patents of defendants' Exhibit II. The same complete hot gas defrosting system and liquid accumulator were taught by the prior Hart article [Exs. P, Q and AT], the Nussbaum '310 patent and were actually publicly used and sold by the Kramer Trenton Company more than five years prior to Quick as "surge" tanks in Kramer Trenton hot gas defrosting systems [Exs. F-N].

The Quick patent adds nothing to the sum of useful knowledge, it does not satisfy the constitutional stand-

ard referred to in the well-known *A & P Supermarket* case, *supra*, and is invalid.

"Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system, which by constitutional command must 'promote the progress of . . . useful art.' This is the standard expressed in the constitution and it may not be ignored."

*Graham v. John Deere Company of Kansas City,*  
*supra*, 86 S. Ct. at 688.

The Quick patent is invalid because it is not novel (35 U.S.C. Sec. 101), because it was in prior public use and was on sale more than one year prior to the filing of a disclosure in the Patent Office which could support the claims sought (35 U.S.C. Sec. 102(b)), because it is obvious to one skilled in the art (35 U.S.C. Sec. 103), because the claims obtained were so changed to avoid the cited prior art in the Patent Office that they no longer define nor distinctly claim the system disclosed in the Quick patent specification (35 U.S.C. Sec. 112) and because the patent was obtained by fraud, the plaintiffs misrepresenting prior art patents and publications to the Patent Office and knowingly filing a false oath with the May, 1955 application.

The metering accumulator used in the defendants' "THAW" system, accused to be an infringement in this action, is merely a horizontal version of the old surge tank used in the same combination with the same operation, function and result as the early Kramer Trenton surge tanks made and sold by Kramer Trenton more than five years before Quick. The plaintiffs' many misstatements, misrepresentations and instances of overreaching outlined herein, are all designed to create a

patent monopoly by semantics out of the prior art heretofore available to the public and to those skilled in the art.

The Judgment below shold be affirmed. It is further requested that in view of the plaintiffs' misconduct before the Patent Office in obtaining the Quick patent and before this Court in attempting to enforce it on defendants unfairly and in bad faith, that the Court further instruct the District Court that this is an exceptional case justifying the award of attorney's fees to defendants.

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### Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

C. A. MIKETTA

